

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/763,638
Applicants : Shridhar P. Joshi, *et al.*
Filed : January 23, 2004
Title : Gaming Terminal With Multi-Level Progressive Jackpot
TC/A.U. : 3714
Examiner : Steven J. Hylinski
Docket No. : 247079-000225USP1
Customer No. : 70243

MS Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CORRECTED APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Sir:

This Corrected Appeal Brief is filed pursuant to the Appellants' appeal to the Board of Patent Appeals and Interferences ("Board") from the final rejection of claims 1-13, 15-25 and 27-37 in the April 21, 2009 Final Office Action. (Exhibit B). An Advisory Action was mailed on July 23, 2009 which maintained the rejections in the April 21, 2009 Final Office Action. (Exhibit C). A Notice of Appeal was filed on September 21, 2009.

A Notice of Non-Compliant Appeal Brief was mailed on March 15, 2010 which noted that grounds for rejection for claims 19-22 and 24 were not discussed in the argument section. This corrected Appeal Brief includes a subsection for the rejection of claims 19-22 in the argument section. The due date for this Corrected Appeal Brief is one month from the mailing date of the Notice of Non-Compliant Appeal Brief and this corrected brief is being timely filed.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the Assignee, WMS Gaming, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in an appeal of this matter.

3. STATUS OF THE CLAIMS

Claims 1-13, 15-25 and 27-37 remain in the application. Claims 14 and 26 were canceled previously.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the last amendment filed on January 13, 2009.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, methods and systems for different game outcomes to achieve identical awards. Claim 1 generally relates to a method for playing a wagering game having a special payout. *See* ¶ 8, Figs. 1, 3, 7a & 7b, U.S. Publication No. 2005/059481¹ (Exhibit A), Specification, ¶ 8). A basic game is presented having a plurality of randomly selected outcomes being selected independently of player

¹ The Publication for the application at issue is being attached for convenience as Exhibit A. Applicant is also providing the corresponding specification paragraph number in this and following sections.

selection. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). The randomly selected outcomes include a special-payout outcome. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). A basic wager is accepted from a player for the basic game between a minimum and maximum amount. (Ex. A, ¶¶ 24, 23, Fig. 6, Spec., ¶¶ 24, 23). An additional, separate side-wager option 18 is presented for a player to place an additional side-wager distinct from the accepted basic wager. (Ex. A, ¶¶ 25, 35 and 44, Fig. 5, Spec., ¶¶ 25, 35 and 44). The side-wager option requires a side-wager amount in addition to the accepted basic wager. In response to a player not choosing the side-wager option, the player is provided with a first probability greater than zero of achieving the special-payout outcome. (Ex. A, ¶ 44, Fig. 7a, Spec., ¶ 44). In response to the player choosing the side-wager option, the player is provided with a second probability of achieving the special-payout outcome with the second probability being greater than the first probability. (Ex. A, ¶¶ 10, 33, 47, Fig. 7b, Spec., ¶¶ 10, 33, 47). The basic game is conducted with the first probability if the player does not choose the side-wager option, or is conducted with the second probability if the player chooses the side-wager option. (Ex. A, ¶ 44, Figs. 7a-7b, Spec., ¶ 44). In response to conducting the game, the player is credited the special payout when the special-payout outcome occurs in the basic game. (Ex. A, ¶ 46, Spec., ¶ 46).

Claim 10 generally relates to a method for playing a wagering game on a gaming terminal 10. (Ex. A, ¶ 22, Figs. 1 and 3, Spec., ¶ 22). The wagering game has a progressive payout. (Ex. A, ¶ 29, Fig. 1, Spec., ¶ 29). A basic game is presented having a plurality of randomly selected outcomes being selected independently of player selection. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). The randomly selected outcomes include a progressive-payout outcome. (Ex. A, ¶¶ 28-29, Fig. 1, Spec., ¶¶ 28-29). A basic wager is accepted from a player for the basic game between a minimum and maximum amount. (Ex. A, ¶¶ 24, 33, Fig. 6, Spec., ¶¶

24, 33). An additional, separate side-wager option 18 is presented for a player to place an additional side wager distinct from the accepted basic wager. (Ex. A, ¶¶ 25, 32, 44, Fig. 5, Spec., ¶¶ 25, 32, 44). The side-wager option requires a side-wager amount in addition to the accepted basic wager. (Ex. A, ¶¶ 25, 32, 44, Fig. 5, Spec., ¶¶ 25, 32, 44). A first spinning reel is provided that provides the player with a first probability greater than zero of achieving the progressive-payout outcome. (Ex. A, ¶ 45, Spec., ¶ 45). A second spinning reel is presented providing the player with a second probability of achieving the progressive-payout outcome, the second probability being greater than the first probability. (Ex. A, ¶ 45, Spec., ¶ 45). In response to the player selecting the side-wager option, the second spinning reel is substituted for the first spinning reel, increasing the player's probability of winning the progressive payout. (Ex. A, ¶ 45, Fig. 5, Spec., ¶ 45).

Claim 12 relates generally to a gaming terminal 10 for playing a wagering game having a special payout with a first payout and a second payout. (Ex. A, ¶ 22, Figs. 1 and 3, Spec., ¶ 22). The gaming terminal 10 includes a basic game having a randomly selected outcome being selected independently of player selection. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). A basic wager input accepts a basic wager from a player for the basic game on at least one of a plurality of paylines. (Ex. A, ¶ 33, Spec., ¶ 33). The basic wager is between a minimum and maximum amount. (Ex. A, ¶¶ 24, 43, Fig. 6, Spec., ¶¶ 24, 43). The gaming terminal 10 has two options for being eligible for the special payout: (i) an additional, separate side-wager input option for placing an additional side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager and (ii) a max-wager option for placing the basic wager at the maximum amount resulting in wagers on each of the plurality of paylines. (Ex. A, ¶¶ 33, 35-36, 43, Fig. 6, Spec., ¶¶ 33, 35-36, 43). In response to

selection of either of the two options, the gaming terminal 10 awards the player the first payout when a first randomly selected outcome is achieved in the basic game. (Ex. A, ¶ 35, Spec., ¶ 35). The gaming terminal 10 awards the player the second payout when a second randomly selected outcome is achieved in the basic game. (Ex. A, ¶¶ 30, 36, Fig. 4, Spec., ¶¶ 30, 36). If neither of the two options is selected, the gaming terminal 10 does not award the player the first payout when the first randomly selected outcome is achieved in the basic game and does not award the player the second payout when the second selected outcome is achieved in the basic game. (Ex. A, ¶ 35, Fig. 4, step 70, Spec., ¶ 35).

Claim 25 generally relates to a gaming terminal 10 for playing a wagering game. The gaming terminal 10 includes a basic game having a plurality of symbols that indicate a randomly selected outcome of the basic game. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). The randomly selected outcome is selected independently of player selection. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). The basic game also has a plurality of paylines. (Ex. A, ¶ 24, Fig. 2, Spec., ¶ 24). A progressive payout has a first payout. (Ex. A, ¶ 29, Figs. 3-6, Spec., ¶ 29). A basic wager input accepts a basic wager from a player for the basic game between a minimum and maximum amount, the maximum amount resulting in wagers applied to each of the plurality of paylines. (Ex. A, ¶ 33, Spec., ¶ 33). A side-wager input device 18 allows a player to place an additional, separate side-wager distinct from the accepted basic wager. (Ex. A, ¶ 24, Spec., ¶ 24). The side-wager option requires a side-wager amount in addition to the accepted basic wager. (Ex. A, ¶ 24, Spec., ¶ 24). The gaming terminal 10 presents the player with two independent options to be eligible for the progressive payout: (i) the player placing the side-wager via the side-wager input device and (ii) the player placing the maximum amount of the basic wager. (Ex. A, ¶ 43, Spec., ¶ 43). In response to either of the two options being chosen, the gaming terminal 10 awards the

player the first payout when a first randomly selected outcome is achieved. (Ex. A, ¶¶ 35-36, Fig. 4, Spec., ¶¶ 35-36). If neither of the two options is chosen, the gaming terminal 10 does not award the player the first payout when the first randomly selected outcome is achieved. (Ex. A, ¶ 35, Spec., ¶ 35).

Claim 28 generally relates to a method for playing a wagering game having a special payout. A basic game having a plurality of randomly selected outcomes selected independently of player selection is conducted. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). A basic wager is accepted from a player for the basic game between a minimum and maximum amount. (Ex. A, ¶ 33, Spec., ¶ 33). The maximum amount results in a wager on each of a plurality of paylines. (Ex. A, ¶ 33, Spec., ¶ 33). An additional, separate side-wager option 18 is presented for a player to place a side-wager distinct from the accepted basic wager. (Ex. A, ¶ 25, Fig. 1, Spec., ¶ 25). The side-wager option 18 requires a side-wager amount in addition to the accepted basic wager. (Ex. A, ¶ 25, Fig. 1, Spec., ¶ 25). In response to the player selecting either the side-wager option or the maximum amount of the basic wager, the player is credited with the special payout when a special-payout outcome occurs in the basic game. (Ex. A, ¶¶ 35-36, Fig. 4, Spec., ¶¶ 35-36). If neither the side-wager option nor the maximum amount of the basic wager is selected, the gaming terminal does not credit the player the special payout when the special-payout outcome occurs in the basic game. (Ex. A, ¶ 35, Spec., ¶ 35).

Claim 29 generally relates to a gaming terminal 10 for playing a wagering game having a special payout. The gaming terminal 10 includes a basic game having a plurality of randomly selected outcomes being selected independently of player selection. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). The randomly selected outcomes include a special-payout outcome that awards the special payout. (Ex. A, ¶¶ 23, 26, Fig. 1, Spec., ¶¶ 23, 26). A basic wager input

accepts a basic wager from a player for the basic game between a minimum and maximum amount. (Ex. A, ¶¶ 24, 23, Fig. 6, Spec., ¶¶ 24, 23). A side-wager input device 18 accepts an additional, separate side-wager distinct from the accepted basic wager. (Ex. A, ¶¶ 25, 32, 44, Fig. 5, Spec., ¶¶ 25, 32, 44). The side-wager option requires a side-wager amount in addition to the accepted basic wager. (Ex. A, ¶¶ 25, 32, 44, Fig. 5, Spec., ¶¶ 25, 32, 44). In response to a player not making a side-wager distinct from the basic wager, the gaming terminal 10 provides the player with a first probability greater than zero of achieving the special payout. (Ex. A, ¶ 44, Fig. 7a, Spec., ¶ 44). In response to the player making a side-wager distinct from the basic wager, the gaming terminal 10 provides the player with a second probability of achieving the special-payout outcome with the second probability being higher than the first probability. (Ex. A, ¶¶ 10, 33, 47, Fig. 7b, Spec., ¶¶ 10, 33, 47). The gaming terminal 19 credits the player the special payout if the special-payout outcome occurs. (Ex. A, ¶ 46, Spec., ¶ 46).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-2, 4-5, 7, 9, 29, 31-32, 34, and 36 were improperly rejected under either 35 U.S.C. 102(b) or 35 U.S.C. 103 based on U.S. Patent No. 6,309,300 (“Glavich” attached as Exhibit D).
2. Whether claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich.
3. Whether claims 6, 17, and 33 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of U.S. Patent No. 6,186,894 (“Mayeroff” attached as Exhibit E).

4. Whether claims 8, 10-11, and 35 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of U.S. Publication No. 2004/0166918 (“Walker ‘918” attached as Exhibit F).

5. Whether claims 19-22 and 24 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of U.S. Publication No. 2003/0064807 (“Walker ‘807” attached as Exhibit G).

The April 21, 2009 Final Office Action rejected Claims 1-2, 4-5, 7, 9, 29, 31-32, 34, and 36 under 35 U.S.C. 102(b) as being anticipated by Glavich. With regard to claims 1 and 29, the Final Office Action argued that Glavich discloses a method of presenting a basic game having a plurality of randomly selected outcomes citing Fig. 1 and element 132. (Ex. B, pp. 3-4). The Final Office Action noted that both the base game slot reel combinations and bonus game picks are randomly selected by the computer. (Ex. B, p. 4). The Final Office Action cited Fig. 2, blocks 234-236 that show the determination of selectable bonus game objects to cause a bonus game selection win. (Ex. B, p. 4). The Final Office Action noted that Glavich discloses making an additional side wager option citing Col. 3, ll. 65-67 and Col. 4, ll. 1-2. (Ex. B, p. 4). The Final Office Action asserted that a player is provided with a first probability of achieving the special-payout outcomes. (Ex. B, p. 4). The Final Office Action noted that different variables such as N, M and Z may be adjusted in response to the player choosing the side wager option. The Final Office Action argued that in response to the player choosing a side wager option, Glavich provides the player with a second probability greater than the first probability of achieving the special payout option citing Col. 5, ll. 26-42 by increasing the number of selectable items N having associated items M. (Ex. B, p. 5). The Final Office Action argued that Glavich discloses conducting the basic game with the first probability if the player does not choose the

side-wager option because it is inherent that if a side wager is not chosen, the game will be conducted according to the base wager. (Ex. B, p. 5). The Final Office Action noted that Glavich discloses conducting the basic game at a second probability if the player chooses the side wager option by increasing the number of selectable bonus objects resulting in winning bonus picks. (Ex. B, pp. 5-6).

With regard to claim 10, the Final Office Action argued that Glavich has the purpose of altering the probability of achieving a winning bonus pick to a player based on changing the number of wins associated with a plurality of symbols. (Ex. B, p. 9). The Final Office Action notes that one of ordinary skill in the art would apply the same teaching of altering the number of winning symbols to a slot reel game since this would not create any results outside of what would be expected by one of ordinary skill. (Ex. B, pp. 9-10). The Final Office Action asserted that Walker discloses an apparatus for changing the number of winning symbols on slot reels to modify the payout. (Ex. B, p. 10).

With regard to claims 12, 25 and 28, the Final Office Action argued that Glavich discloses there are various types of associated items such as those in Fig. 1 which have one of various types of associated items citing Col. 4, ll. 44-67 and Col. 5, ll. 1-16. (Ex. B, p. 7). The Final Office Action noted that one of skill in the art would recognize that a system with hidden prizes that may be varied based on side wagers and addition wagers would encompass varying the types of hidden prizes when a max wager occurs because a max wager is the highest form of an additional wager. (Ex. B, p. 7).

7. ARGUMENT

For the convenience of the Board, claims 1-11 and 29-37 will stand or fall as one group. Claims 12-13, 15-23, 25, and 27-28 will stand or fall as a second group. The primary reference

cited by the Final Office Action is Glavich. As will be explained below, the Examiner improperly combines features from both the base game and base game described in Glavich to match the claim elements.

A. Claims 1-2, 4-5, 7, 9, 29, 31-32, 34, and 36 Were Improperly Rejected Under Either 35 U.S.C. 102(b) Or 35 U.S.C. 103 Based On Glavich

1. Glavich Is An Entirely Different Game Then That Of The Claims

There are fundamental differences between the claimed subject matter and Glavich that mandate that the pending claims are allowable over Glavich. The pending claims relate primarily to a method and gaming terminal for providing the player with multiple ways to achieve a special payout in a basic game. For example, claims 1, 10 and 29 present a basic game having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome. A basic wager is accepted from a player for the basic game between a minimum and maximum amount. An additional, separate side-wager option is presented for a player to place an additional side-wager distinct from the accepted basic wager. If the player does not choose the side-wager option the player is provided with a first probability greater than zero of achieving the special-payout outcome. If the player chooses the side-wager option, the player is provided with a second probability of achieving the special-payout outcome. The basic game is conducted with the first probability if the player does not choose the side-wager option, or the second probability if the player chooses the side-wager option. The player is credited with the special payout when the special-payout outcome occurs in the basic game.

Similarly, claims 12, 25 and 28 provide a player either a side-wager or a max-bet option that give the player the opportunity to win special payouts. If the player does not wager either

the side wager or make a max-bet, the player is not eligible for the opportunity to win the special payouts.

Glavich relates to a different type of game than those of the claims since the basic game in Glavich triggers a bonus game whose outcomes are then affected by maximum betting or a side wager after the outcome of the basic game is determined. Unlike the claims, the outcomes in the basic game in Glavich are not affected by a player making a side wager or a maximum bet. Glavich discloses a wagering game with a main game 214 that provides a bonus trigger event 216 that triggers a bonus game as shown in Fig. 2. (Ex. D, Col. 3, ll. 43-57).

Also, the nature of the special-payout are significantly different in Glavich. The bonusing features in Glavich allow a player to select up to “Z” number of “N” number of selectable items in the bonus game. (Ex. D, Col. 3, ll. 58-65). A player may be given an option to increase N or Z for a side wager. (Ex. D, Col. 3, l. 65 – Col. 4, l. 7, Col. 4, ll. 33-40). Glavich allows another variable, M, which is the number of selectable items that actually have associated awards. (Ex. D, Col. 5, ll. 24-30). Glavich specifically notes that “there may be some selectable items which have no associated items (or, equivalently, which are associated with blank or zero-value associated items) such that, upon selecting such a selectable item, there is no affect upon the total prize.” (Ex. D, Col. 5, ll. 18-23). Glavich does not disclose effecting outcomes in a basic game since all of the outcomes that may be changed are in the bonus game. Further, Glavich does not disclose awarding a special-payout outcome from the basic game since the only outcome is the opportunity to play a bonus feature.

The Final Office Action and Advisory Action have erred in their interpretation of Glavich by asserting: a) Glavich should be interpreted as the overall base and bonus game functionality as one “basic game” to apply features to either the bonus game or the basic game (Ex. C, pp. 2-

3); and b) the opportunity of making a “bonus game” selection that may result in a win should be interpreted as “a special-payout outcome of the basic game” (Ex. C, p. 2). As will be explained, the Final Office Action improperly interprets the disclosure of Glavich in contradictory ways to attempt to match the claim language.

2. Claims 1 and 29 Require A Basic Game With A Random Outcome Including A Special-Payout Selected Independently Of Player Selection

Claims 1 and 29 require that the randomly selected outcomes that include the special-payout outcome and the progressive-payout outcome is “selected independently of player selection.” Glavich does not anticipate or render obvious these elements as the player in Glavich directly selects the outcomes that include the special-payout option in the bonus game. Even if the outcomes of the bonus game are an outcome of the basic game as asserted by the Final Office Action (Ex. B, p. 2), the only payout outcome in the “bonus payout” outcome requires a player to select one of the M elements in the bonus game with an outcome associated with it. In contrast, the special-payout outcome or progressive-payout outcome is **randomly selected independently of player selection** in claims 1 and 29.

The Final Office Action has asserted that the basic game has spinning slot reels and the picks of the bonus games are randomly selected by the gaming terminal (Ex. B, pp. 2-3) and therefore the outcomes are selected independently of player selection in Glavich. However, even this strained interpretation fails to meet the claim elements. Claims 1 and 29 require “a plurality of randomly selected outcomes being selected independently of player selection” including a special-payout outcome or a progressive payout outcome. If the outcomes of the bonus game in Glavich are part of the basic game as asserted by the Final Office Action, such outcomes all require player selection of the outcome. This interpretation therefore does not anticipate claims

1 and 29. If the bonus game itself is the special-payout outcome as asserted by the Final Office Action and the Advisory Action (Ex. B, p. 2, Ex. C, p. 2), other elements of claims 1 and 29 such as different probabilities of achieving the bonus game as will be detailed below are not anticipated.

3. Glavich Does Not Disclose A Basic Game With A Special Payout As Required By Claims 1 and 29; The Outcomes Of A Bonus Game Are Not A Special Payout Of The Basic Game Because It Requires Intervening Action By A Player To Be Awarded An Award Unlike A Special-Payout

Claims 1 and 29 also all require a basic game having a plurality of outcomes including a “special-payout.” As explained above, Glavich relates to a bonus game that allows a player to make a special wager to increase the chance of selecting an element in the bonus game alone, but which has no effect on the outcomes of the basic game that trigger the bonus game. However, contrary to the assertions of the Final Office Action, the opportunity of achieving a winning outcome by being awarded a bonus game is not a special-payout as defined by the present claims. First, there is no guarantee that the bonus game in Glavich will pay anything to a player. Glavich specifically notes that there are instances where the player selectable elements award nothing. (Ex. D, Col. 5, ll. 18-23). Contrary to the assertion of the Final Office Action, a payout is generally understood to mean a guaranteed return if the outcome is achieved. Achieving a play of the bonus game in Glavich does not guarantee any award value since a player may select elements that award nothing.

Second, an outcome that does not directly award a value to a player is not a payout as conventionally understood by one of ordinary skill in the art. The Final Office Action has offered no evidence that the outcome of an opportunity to play a bonus game falls under the definition of a “payout.”

Third, Glavich makes a clear delineation between the main or basic game which must be played first and the bonusing feature which is initiated by the bonus game. Glavich states that:

In general, the main game 214 is distinguishable from a bonusing feature because there must be at least some amount of play of the main game, before initiating of the bonusing feature, and/or because the main game is the game which is most prominently featured or displayed on the gaming terminal and/or because the main game is the game on which the player wagers.

(Ex. D, Col. 3, ll. 36-42, emphasis added). It is clear that the play of the main game in Glavich is separate from the bonus game. Glavich also clearly defines the opportunity of playing a bonus game as a definite outcome of the basic game.

[T]he bonusing feature is initiated upon the occurrence of a bonus trigger event 216. If a bonus trigger event does not occur a procedure returns 218 to permit another wager and main game play if desired. In some embodiments, the bonus trigger 216 relates to outcomes or other aspects of the main game such as achieving certain main game results (e.g., achieving one or more bonus symbols 138 on a slot machine pay line 142, FIG. 1), play of a certain number of rounds of the main game, wagering of at least a threshold amount, accumulation of a threshold point, credit or prize amount in the main game and the like.

(Ex. D, Col. 3, ll. 43-53, emphasis added). Nowhere does Glavich support the assertion that the outcomes of the separate bonus feature are included in the outcomes of the basic game.

The Advisory Action asserts that the “a bonus game pick resulting in a win can be interpreted as a special-payout outcome.” (Ex. C, p. 2). The Advisory Action concludes that “the claims as presented do not disallow this interpretation.” (Ex. C, p. 2). This position flies against both Glavich and the plain language of the claims. As explained above, Glavich makes a clear distinction between the basic game and the bonus game. The elements of the bonus game in Glavich cannot therefore be applied to the distinct basic game. By having a distinct bonus game, Glavich teaches away from the concept of a unified basic game with the claimed features.

Further, Applicant contends that the special-payout outcome is a payout that is certain and what the Advisory Action has noted is one outcome of a plurality of outcomes that include

the possibility of no award at all. The Advisory Action therefore ignores the position that 1) an outcome that is a payout is commonly understood as a certain or guaranteed payout; and 2) the fact that the outcome of a providing a bonus pick which when correctly selected results in a win is only one outcome of the pick and therefore cannot be construed as a “payout outcome” because there is an intervening step, the player is not automatically awarded anything but the potential for making a winning selection.

4. Glavich Does Not Conduct The Basic Game With Different Probabilities Based On Selection Of The Side-Wager Option As Required By Claims 1 and 29

Claims 1 and 29 require conducting the basic game with the first probability if the player does not choose the side-wager option, or the second probability if the player chooses the side-wager option. Glavich does not disclose these elements because Glavich does not provide the player the option to make a side-wager option until after an outcome of the basic game is achieved. (Ex. D, Col. 3, l. 66- Col. 4, l. 2). The play of the basic game must be complete prior to initiating the bonus game. (Ex. D, Col. 3, ll. 36-41). Therefore, the probabilities of the basic game cannot be different because the side-wager option is offered after the basic game is conducted at a first probability in Glavich.

The Advisory Action has asserted that the entirety of Glavich indicates that the basic game and the bonus game are functionally tied together. (Ex. C, pp. 2-3). However, the Advisory Action fails to provide any support in Glavich of the alleged assertion that the basic game features may be imparted with the separate bonus game. If anything, Glavich makes it clear that the basic or main game is distinct from the bonus game. Further, the Advisory Action fails to provide any evidence or procedure that it is proper to combine the elements of features that are distinct according to the reference, Glavich, to anticipate the claims elements. As noted

in section 2 above, if the bonus game is combined with the basic game then the outcomes are not selected independently of player selection and that element of the claim is not met by Glavich. Claims 1 and 29 and their dependents are therefore allowable over Glavich as either Glavich discloses different bonus and basic games which do not conduct the basic game with different probabilities depending on a side wager, or as the Final Office Action asserts, the entirety of Glavich is a basic game in which case the outcomes are selected by the players and therefore do not meet the requirement that the outcomes are randomly selected.

B. Claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37 Were Improperly Rejected Under 35 U.S.C. 103(a) As Being Unpatentable Over Glavich.

1. Claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37 Require A Basic Game With A Random Outcome Selected Independently Of Player Selection And A Special Payout

As explained above, independent claims 12, 25 and 28 are allowable because Glavich does not disclose a basic game with a random outcome selected independently of player selection or a basic game that includes a special payout. Accepting the interpretation of the Final Office Action, the “combination” basic game and bonus game allegedly disclosed in Glavich does not include outcomes selected independently of player selection because the player in Glavich makes selections in the Glavich bonus game. Claims 3, 13, 15-16, 18, 23, 27 and 30 and 37 depend from these independent claims or claims 1 and 29 above. These claims are allowable over Glavich at least because of these reasons.

2. Claims 12, 25 and 28 Require Not Awarding Payouts When Outcomes Are Obtained; Glavich Always Awards Payouts When Outcomes Are Obtained

Claims 12, 25 and 28 require “if neither of the two options is selected, the gaming terminal does not award the player the first payout when the first randomly selected outcome is

achieved in the basic game and does not award the player the second payout when the second selected outcome is achieved in the basic game.” Glavich does not teach this element. Even if the player does not wager the maximum or offer a side-wager, the outcome of a bonus game may still be achieved by the player in Glavich. (Ex. D, Col. 2, ll. 43-44). Further, even if the bonus game picks are considered “special-payout outcomes,” Glavich does not disclose this element. As the Final Office Action asserts, changing the number, M, of selectable outcomes associated with a favorable result only changes the probability of winning a prize, it does not change the existence of the outcome. (Ex. B, pp. 2, 5). Thus, the outcome in Glavich is still available to be awarded to a player who does not max bet or provide a side wager.

The Final Office Action has asserted that it would be obvious to eliminate certain items such as bonus values or free plays when a max wager or side wager is not made. (Ex. B, pp. 7-8). Glavich does not disclose or suggest such a concept. Glavich only discloses varying the numbers of items (N), selections (Z), or number of items with prizes (M) based on a wager. Glavich is silent as to whether the types of prizes may be varied based on the wager type. In fact Glavich teaches the opposite, that any “associated item can include various prizes” and therefore there is no range of prizes that is excluded based on a player wager. (Ex. D, Col. 4, ll. 44-53).

C. Claims 6, 17, and 33 Are Improperly Rejected Under 35 U.S.C. 103(a) As Being Unpatentable Over Glavich, In View Of Mayeroff

Claims 6, 17 and 33 depend from claims 1, 10 and 29 respectively and are allowable for the same reasons discussed in this paper that these claims are allowable.

D. Claims 8, 10-11, and 35 Are Improperly Rejected Under 35 U.S.C. 103(a) As Being Unpatentable Over Glavich In view Of Walker ‘918”

1. Claims 8, 10-11 and 35 Are Allowable As They Require A Basic Game With A Random Outcome Selected Independently Of Player Selection and A Special Payout

As explained above, claim 10 is allowable because Glavich does not disclose a basic game with a random outcome selected independently of player selection or a basic game that includes a special payout. The other claims also depend from either claims 1 and 29 that have this element and therefore are allowable.

2. Claims 3, 10-11 and 25 Require A Progressive Game Payout

Dependent claim 3 requires that a progressive payout is “contributed to by a plurality of gaming machines including a gaming machine playing the wagering game.” Claims 10 and 25 also require a progressive payout. Glavich does not disclose a progressive payout or such a payout that is contributed from a plurality of gaming machines. The Final Office Action cites Col. 4, ll. 44-52 for Glavich as disclosing that the items may include monetary prizes which “obviously includes a progressive payout.” (Ex. B, p. 7). The Final Office Action offers no rationale why monetary prizes encompass a progressive payout as required by claims 10 and 25. Even accepting this rationale, monetary prizes does not include a payout “contributed to by a plurality of gaming machines including a gaming machine playing the wagering game” as required by claim 3 because Glavich only discloses a single gaming machine. Claims 3, 10 and 25 are therefore independently allowable over Glavich.

The Advisory Action asserts that one of ordinary skill in the art would recognize that varying the types of monetary prizes include progressively funded monetary prizes. (Ex. C, p. 4). The Advisory Action has failed to satisfy the basic burden of non-obviousness by providing any evidence that Glavich would encompass progressives that require a contribution from multiple machines. Further there is nothing in this section of Glavich that even indicates that monetary prizes may include different types of monetary prizes such as varying the funding

source or even the amount. (Ex. D, Col. 4, l. 47). The single mention of a monetary prize in Glavich does not render a progressive award element obvious as in these claims.

E. Claims 19-22 And 24 Were Improperly Rejected Under 35 U.S.C. 103(a) As Unpatentable Over Glavich In View Of Walker '807

Claims 19-22 and 24 depend from claim 12 and are allowable for the same reasons discussed in this paper that claim 12 is allowable.

Conclusion

For at least the foregoing reasons, the final rejection of appealed claims 1-13, 15-25 and 27-37 set forth in the April 21, 2009 Final Office Action, should be reversed.

Respectfully submitted,

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